REMARKS

Claims 1, 4 and 7-11 are pending in the present application, of which claim 1 is the sole independent claim. Claims 1, 4 and 7 have been amended. Claims 2-3 and 5-6 have been canceled. The limitations of claim 6 were incorporated into claim 1. New claim 11 has been added; support for it is found in the specification on page 4, lines 19-20.

The abstract has been objected to for use of the word "comprising." Applicant submits herewith a replacement abstract which does not contain this word. The abstract also was modified to reflect the changes in claim 1.

Claims 1-10 were rejected under 35 U.S.C. § 103(a) over Reale, Jr. (U.S. Pat. No. 3,901,815; hereinafter "Reale"). Applicant respectfully traverses this rejection.

Claim 1 has been amended to require that the "R^3 and R^4 groups combine with ring carbon atoms to which they are attached to form a five- to seven-membered heterocyclic ring." This was one of the original choices for R^3 and R^4, along with the now-deleted "hydrogen, alkyl, alkenyl, aryl or aralkyl." Nothing in Reale suggests adding to a lubricating oil a cyclic thiourea fused to a five- to seven-membered heterocyclic ring. There is no disclosure of any fused-ring systems at all, and the substituents, "R" on the thiouracils or dithiouracils are described only as "hydrogen or a hydrocarbyl radical," leaving no possibility of adding any kind of heteroatom-containing substituent to the base ring system. Accordingly, claim 1 and its dependent claims, including claims 7-11, which further recite a specific heterocyclic ring fused to the thiourea, cannot be obvious over Reale.

Claim 1 was rejected provisionally for obviousness-type double patenting over claims 1-10 of copending application Ser. No. 10/637,030. Applicants acknowledge the provisional double patenting rejection, but will not respond at this time, as the '030 application is still pending. Applicant respectfully submits that the amendments and remarks made herein have overcome the Section 103 rejection, and that when "the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent." M.P.E.P. § 804(I)(B)(¶2).

Applicant wishes to address the comments in paragraph 7 of the Office Action, on page 6. This refers to potential rejections based on the copending '030 application under 35 U.S.C. § 102(e), (f) or (g), and calls for a showing of common ownership of the present application and the '030 application. Applicant respectfully submits that such a showing is not necessary because the cited sections do not apply where, as here, both the present application and the reference have the same sole inventor. Sections 102(e) and (g) explicitly refer to "another" inventor,

whereas here Applicant is the sole inventor in both applications. Section (f) is directed to the situation where an applicant "did not himself invent the subject matter." Here, even if an overlap between the subject matter of the two applications were to be established, all of the subject matter in both applications is the work of Applicant. Therefore, any rejection based on these sections is not possible in this case.

If the Examiner has any concerns regarding the application, Applicant respectfully requests that the Examiner contact Applicant's undersigned attorney by telephone to discuss the issues.

Respectfully submitted,

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